

data file as appropriate for obtaining a corresponding plurality of imagery products, without having to rescan the motion picture film;  
choosing a particular imagery product;  
selecting a processing command set from the processing file library for the particular imagery product;  
applying the selected processing command set to the digital data file to generate a derivative image dataset; and  
using the derivative image dataset to generate the particular imagery product.

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### REMARKS

Claim 17 has been amended to remove the Examiner's objection that it was not drawn to a statutory subject.

Claims 11-17 and 22-27 are rejected under 35 USC §102(b) as being anticipated by U.S. Patent No. 5,999,220 to Washino. Claims 1-10 and 18-21 are rejected as being unpatentable under 35 USC §103(a) over Washino as applied to claim 11-17 and 22-27 above, and further in view of U.S. Patent No. 5,808,669 to Schmutz et al.

#### **General comments.**

Washino describes a universal playback system that enables a user to edit and manipulate an input video program and produce an output version of the program in a final format which may have a different frame rate, pixel dimensions, or both (col. 2, lines 4-7). The intent of Washino is to encourage production at relatively low pixel dimensions to make use of lower-cost general-purpose hardware and to maintain high signal-to-noise, then subsequently expand the results into a higher-format final program (col. 2, lines 33-37). He specifically contrasts his approach to competing approaches, "“which recommend operating at higher resolution, then down-sizing, if necessary, to less expensive formats...” (col. 2, lines 37-40).

In short, there is nothing in Washino that suggests starting with “a full fidelity rendition of the imagery on the motion film”, which is recited in all the independent claims of the present application. In Washino, the input imagery is captured by “conventional CCD-type cameras” (col. 3, lines 47-48), with fewer

than 1200 scan lines, with picture expansions to create a hierarchy of upward-converted formats for theatrical projection, film effects, and film recording (col. 1, lines 56-61; col. 4, lines 22-29). Importantly, by employing the more conventional CCD-elements in the camera systems of his invention, he relies "upon the computer to create the HDTV-type image by image re-sizing" Col. 5, lines 64-67). There is no suggestion otherwise in this disclosure. Thus, by his own very definition, and as would clearly be understood by anyone of ordinary skill in this art, Washino does not start with "a full fidelity rendition of the imagery on the motion picture film".

This difference in operation between Washino and the present invention has a profound consequence: the system of Washino would not work in the present invention because the fidelity of the input could not produce the results imparted by the present invention. In that sense, Washino may be said to teach away from the claimed invention. "A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant. The degree of teaching away will of course depend on the particular facts; in general, a reference will teach away if it suggests that the line of development flowing from the reference's disclosure is unlikely to be productive of the result sought by the applicant." *In re Gurley*, 31 USPQ2d 1130, 1131 (Fed. Cir. 1994). Clearly, the TV resolution of the input would have suggested that the line of development flowing from the Washino disclosure would be unlikely to be productive of the result sought, namely, the production of multiple imagery products from a set of data which has been obtained by a one time optical scan of motion picture film.

Washino makes reference to film in a couple of ways. Most frequently, it is a comparative reference, such as in col. 11, lines 36-38, where he compares his procedure to the procedure utilized for performing conversion of 24 fps film material to 25 fps PAL-format video usage. Another reference is to the use of the video output for driving a film recording function (such as film output video interface 836 in Fig. 8, and col. 15, lines 33-35). Finally, Washino refers to the reception of film-based elements 160 (Fig. 5) and to the combination of such elements with locally produced video materials already in the internal production

format of 24 frames-per-second (col. 13, lines 37-40). Washino is silent as to the scanning of these elements, as they play a minor role in his system, but it is clear that they are not based on "a full fidelity rendition of the imagery on the motion picture film".

**Rejection of claims 11 – 17 and 22 – 27 under 35 USC §102(b).**

With regard to the rejection of claims 11-17 under 35 U.S.C. § 102(b), the preamble requires that the multiple imagery products arise "...from a single scan of motion picture film that provides a full fidelity rendition of the imagery on the motion picture film." (claim 11). (If a patentee uses the claim preamble to recite structural limitations of the claimed invention, the PTO and courts give effect to that usage, *Rowe v. Dror* 42 USPQ2d 1550 (Fed. Cir. 1997), also see *MPEP 2111.02*). In the body of their claims, claims 22 - 27 likewise state that "full fidelity is taken to mean the substantial preservation of the spatial resolution and colorimetric profile of the motion picture film".

As stated above, nothing in Washino teaches or suggests the "full fidelity rendition" required by the claims. Indeed, Washino is purposefully teaching in the opposite direction by explicitly encouraging production at relatively low pixel dimensions to make use of lower-cost general-purpose hardware and thus maintaining high signal-to-noise, then subsequently expanding the results into a higher-format final program (col. 2, lines 33-37).

In connection with claims 22 – 27, the Examiner further asserts that Washino teaches of a file format including an image element (DVD 802). This argument is inappropriate because the video encoding formats described by Washino are not file formats at all. Washino simply describes a device (a video playback unit) upon which data is stored and a particular video format in which the image is encoded. Washino specifically mentions MPEG, MPEG-2 and motion JPEG. MPEG and MPEG-2 are specifically video encoding schemes; not digital file formats in the same vein as the SMPTE 268M-1994 format cited, e.g., in the current application claim 27. (The application specifically cites SMPTE 268M-1994 as the storage format because of its ability in a single, standardized format to be able to store the imagery data as well as all the metadata required to fully describe the initial images and all derivative products.) Motion JPEG does contain a header structure for each compressed frame, but the header is merely

data which is utilized by the video decoder in order to decode/decompress the video frames. Hence, it can be reasonably argued that motion JPEG is simply a slightly more robust video encoding scheme.

The Examiner seems to suggest that the structure and function of Washino would have inherently led to the claim limitations. However, there is nothing at all in Washino that explicitly describes any file format at all. Even if we grant that there would be some kind of format at play in Washino, there is nothing at all that suggests the image element plus metadata format of claim 22, where the file format comprises an image element "that contains digital data providing a full fidelity rendition of the imagery on the motion picture film, .....; and a processing element that contains processing data that is capable of converting the digital data into a corresponding plurality of imagery products." The current application also introduces the idea of carrying forward metadata within the single file format which can be utilized to produce the plurality of image products (claims 22 and 26), which is nowhere shown, suggested or inherent in Washino.

It is axiomatic that for prior art to anticipate under §102 it has to meet every element of the claimed invention. *Hybritech Inc. v. Monoclonal Antibodies, Inc.* 231USPQ 81, 90 (Fed. Cir. 1986). Anticipation under 35 U.S.C. Section 102 requires the disclosure in a single piece of prior art of each and every limitation of a claimed invention. *Rockwell International Corp. v. United States* 47USPQ2d 1027, 1031 (Fed Cir. 1998). The foregoing remarks indicate that each of the claims 11 - 17 and 22 - 27 include one or more claimed elements that are not to be found or suggested by the Washino reference. For anticipation to be found, all of the claimed elements must be found in Washino. Since that is not the case with respect to each and every one of the claims 11 - 17 and 22 - 27, the Examiner is respectfully asked to withdraw the rejection of these claims under 35 U.S.C. 102(b) and to consider allowance of the claims.

**Rejection of claims 1 - 10 and 18 - 21 under 35 USC §103(a).**

The rejection of claims 1-10 and 18 - 21 on the basis of Washino and U.S. Patent No. 5,808,669 to Schmutz et al is also contested. While Schmutz teaches that telecine scanning of motion picture film to convert the film record to digital data was well known in the art, it is not obvious that the end product of the

scan would be a full-fidelity (colorimetrically and spatially) digital file representing each frame of film. Also, a reading of Washino reveals the obvious implication that all imagery products both input and output are video images, and more would not be expected of Schmutz et al. in combination with Washino.

As stated above, there is nothing in Washino that teaches or suggests the "full fidelity rendition" required by the claims. Further, there is no suggestion in Washino of the separate provision of a plurality of processing files that convert the digital data into a corresponding plurality of imagery products, and then the selection and application of a particular file to generate the digital data. Washino instead discloses a group of processors and interfaces 830, 832, 834 and 836 (Figure 8), which separately and independently undertake to generate the disclosed outputs. More specifically, as claimed in claims 18 – 21, a processor accesses a selected processing file from a system component having access to a plurality of such files. The processor then utilizes the selected processing file to generate the particular imagery product. Nothing in the combination of Washino with Schmutz et al. would suggest such a configuration of the processing resources.

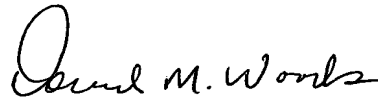
Accordingly, the combination of these two references is not believed to teach the invention as claimed in 1 – 10 and 18 – 21, and these claims are therefore believed to be allowable.

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The new claims further define details associated with a calibrated scanner and with "a full fidelity rendition of the imagery on the motion film" (which is disclosed on page 7, lines 29 – 33 and page 12, lines 21 – 30 of the specification) and with the process for utilizing the processing command sets to produce derivative image datasets, from which the imagery products are obtained (which is generally disclosed on page 8).

Applicants respectfully request reconsideration of claims 1-27, as well as new claims 28 and 29, in view of these remarks and arguments, which applicants believe make a reasonable case for patentability of the claims.

Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached pages are captioned "Version with Markings to Show Changes Made".

Respectfully submitted,

A handwritten signature in cursive script, reading "David M. Woods", positioned above a horizontal line.

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**Version with Markings to Show Changes Made**

**In the Claims:**

Claim 17 has been amended as set forth below:

17. (once amended) [In a] A method for producing multiple imagery products from a single scan of motion picture film that provides a digital data file offering a full fidelity rendition of the imagery on the motion picture film, wherein full fidelity is taken to mean the substantial preservation of the spatial resolution and colorimetric profile of the motion picture film, the improvement wherein the multiple imagery products are enabled by storing a plurality of processing files that are capable of converting the digital data file into a plurality of imagery products.

Claims 28-29 are new.